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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/670,283	09/26/2003	Fumihiko F.S. Sato	242804US-2 CONT	6508
22850	7590	02/07/2007		
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			EXAMINER PARKER, BRANDON	
			ART UNIT	PAPER NUMBER
			2174	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/07/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/670,283

Applicant(s)

SATO, FUMIHIKO F.S.

Examiner

Brandon Parker

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 17 and 18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 17 and 18 is/are rejected.
- 7) ☒ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 9/26/2003.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

Claims 17 and 18 are presented for examination

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Omum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 17 and 18 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6667749 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent. Although the conflicting claims are not identical, they are not patentably distinct from each other because of the following:

Patent 6667749	Application 10/670283
Claim 1: A user interface system, for displaying an operation	Claim 17: A user interface system, for displaying an operation

<p>menu and transferring contents of said operation menu based on an operation input received in response to the operation menu being selected, comprising:</p> <p>a processor configured to execute a process requirement corresponding to the operation input; a group of independent software objects configured to display the operation menu and to transfer the contents of said operation menu in response to the operation menu being selected, said group of independent software objects including:</p> <p>a menu flow software object configured to control the transfer of the contents of the operation menu and <u>to manage menu display layout</u>; and an operation software object separate from the menu flow software object and functioning in cooperation with the menu flow software object to control processing of the operation input by the processor;</p> <p><u>wherein the operation software object comprises: an operational information memorizing object configured to store contents of the operation software object; and an operation controlling object separate from the operational information memorizing object and functioning in cooperation with the operational information memorizing object to create, change, and delete the input operation.</u></p>	<p>menu and transferring contents of said operation menu based on an operation input received in response to the operation menu being selected, comprising:</p> <p>a processor configured to execute a process requirement corresponding to the operation input; a group of independent software objects configured to display the operation menu and to transfer the contents of said operation menu in response to the operation menu being selected, said group of independent software objects including:</p> <p>a menu flow software object configured to control the transfer of the contents of the operation menu; and an operation software object separate from the menu flow software object and functioning in cooperation with the menu flow software object to control processing of the operation input by the processor to create, change, and delete the input operation.</p> <p>Claim 18:</p> <p>An image forming apparatus including....</p>
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Claims 1 of Patent 6,667,749 contains every element of claims 17 and 18 of the instant application and thus anticipates the claims of the instant application. Claims of the instant application therefore are not patently distinct from the earlier patent claims and as such are unpatentable over obvious-type double patenting. A later patent/application claim is not patentably distinct from an earlier claim if the later claim is anticipated by the earlier claim.

"A later patent claim is not patentably distinct from an earlier patent claim if the later claim is obvious over, or anticipated by, the earlier claim. In re Longi, 759 F. 2d at 896,

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225 USPQ at 651 (affirming a holding of obviousness-type double patenting because the claims at issue were obvious over claims in four prior art patents); In re Berg, 140 F.3d at 1437, 46 USPQ2d at 1233 (Fed. Cir. 1998) (affirming a holding of obviousness-type double patenting where a patent application claim to a genus is anticipated by a patent claim to a species within that genus).” ELI LILLY AND COMPANY v BARR LABORATORIES, INC., United States Court of Appeals for the Federal Circuit, ON PETITION FOR REHEARING EN BANC (DECIDED: May 30, 2001).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 17 and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Bertram et al (US Patent 5,818,446) Bertram hereinafter

With respect to claim 17

- Bertram teaches a user interface system, for displaying an operation menu and transferring contents of said operation menu based on an operation input received in response to the operation menu being selected, comprising:
(loading/transferring Bertram Claim 1)

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- a processor configured to execute a process requirement corresponding to the operation input; (Col 2 lines 30-33)
- a group of independent software objects configured to display the operation menu and to transfer the contents of said operation menu in response to the operation menu being selected, said group of independent software objects including: (software processes, user interfaces/independent software objects load/transfer, Bertram Claim 1)(Abstract)
- a menu flow software object configured to control the transfer of the contents of the operation menu; (Col 2 lines 50-55)
- an operation software object separate from the menu flow software object and functioning in cooperation with the menu flow software object to control processing of the operation input by the processor to create, change, and delete the input operation (browser, menu bar/operation software object Col 1 lines 45-51)

Claim 18 is similar in scope to claim 17 and is therefore rejected under similar rationale.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brandon Parker whose telephone number is 571-270-1302. The examiner can normally be reached on Monday thru Friday 7:30am - 5:00pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kristine Kincaid can be reached 571-272-4063. The fax phone number for the organization where this application or proceeding is assigned is 571-270-2302.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

BP
1/31/2006



Brandon Parker
Patent Examiner
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